

Appl. No. 10/665,539
Amendment dated January 30, 2006
Response to Office Action of September 30, 2005

REMARKS/ARGUMENT

This Amendment is submitted in response to the Office Action mailed September 30, 2005, which was non-final. In the September 30, 2005 Office Action, the Examiner rejected claims 1-10 under 35 U.S.C. § 102(b) as being allegedly anticipated by the Berghash and Frost Rule 131 inventor affidavits submitted on August 8, 2005; rejected claims 1-8 as being allegedly anticipated by U.S. Patent No. 2,497,749 (*Wagner*); and rejected claims 1, 9 and 10 as being allegedly anticipated by U.S. Patent No. 3,037,320 (*Powell*).

The Applicant appreciates the Examiner's assistance in the examination of this application, and wishes to thank the Examiner for the telephone interview of December 16, 2005. The Applicant has amended the only independent claim, claim 1, in accordance with the Examiner's instructions to positively claim a hockey stick and to clarify that a hockey stick may pass through the openings at both ends of the interior grip portion.

This application was filed with a total of ten claims. Of these, only claim 1 is presented in independent form. Claim 9 has been canceled. Claims 2-8 and 10 are severally dependent, either directly or indirectly, on claim 1. Applicants respectfully request reconsideration of the stated grounds for rejection in the light of the foregoing amendment and the following argument.

§ 102(b) Rejection — Berghash & Frost Rule 131 Inventor Affidavits

In the Reply dated August 8, 2005, Applicants submitted Rule 131 inventor affidavits to establish that the Applicants invented the subject matter of the claims prior to the effective date of a patent application filed by Tyler. In the September 30, 2005 Office Action, the Examiner

Appl. No. 10/665,539
Amendment dated January 30, 2006
Response to Office Action of September 30, 2005

acknowledged that the Rule 131 affidavits were sufficient to overcome the *Tyler* reference. However, the Examiner rejected claims 1-10 on the basis that the Rule 131 affidavits show conception prior to September 2002 and reduction to practice in July 2002. Applicants respectfully submit that the Rule 131 affidavits do *not* demonstrate any activity resulting in the application of 35 U.S.C. § 102(b). Section 102(b) provides as follows:

A person shall be entitled to a patent unless. . .

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Neither “conception” nor “reduction to practice” forms a basis for anticipation under § 102(b), or any other statute. Rather, § 102(b) requires a sale, offer for sale or public use in the United States more than one year before an application is filed. That did not occur in this case.

Mr. Frost’s affidavit demonstrates that the claimed invention was conceived of prior to the effective date of the *Tyler* reference (January 8, 2003), and that conception was followed by diligence from a time prior to *Tyler*’s effective date until actual reduction to practice in 2003. Specifically, Mr. Frost’s affidavit establishes that the claimed invention was conceived on or before April 17, 2002, and that prototypes made in December 2002 (less than one year before the filing date of this Application) reflected Mr. Frost’s April 17, 2002 design and drawing (Frost Affidavit ¶ 3; Berghash ¶¶ 4-5). As described in Applicants’ Reply dated August 8, 2005, the samples and prototypes establish reduction to practice of the claimed invention as of

Appl. No. 10/665,539

Amendment dated January 30, 2006

Response to Office Action of September 30, 2005

December 2002, prior to the effective date of the Tyler reference, but within one year of filing the Application. Additional prototypes/reductions to practice were completed in January, February and August, 2003, and the first sale was made on August 26, 2003 (Berghash Affidavit Ex. L). The first public disclosure of the claimed invention was the display of a model or prototype at a trade show in January 2003 (Berghash Affidavit ¶ 6).

Thus, the Rule 131 inventor affidavits do not show a sale or public use more than one year before the filing date of the application. Rather, they show conception before the date of the Tyler reference; diligence in reducing the invention to practice; and the first sale and public disclosure within one year of the filing of this Application.

The Claims Are Not Anticipated By Wagner

Applicants respectfully submit that the claims as amended clearly distinguish from the Wagner reference. Wagner discloses a finger and hand shield “manufactured from a blank consisting of a single piece of flexible material and including an elongated arm merging into an outwardly flaring portion. . .” (Col. 1, lines 10-13). Also, the hand and finger shield of Wagner is composed of a single, two-dimensional piece of flexible material.

Significantly, the “elongated finger or cavity” of Wagner which is adapted to receive a piece of chalk is “sewed together at the free side edges thereof *and* at the bottom portion.” (Col. 2, lines 8-13)(emphasis added). The sewing of the bottom edge and the free sides of the chalk cavity is also clearly illustrated in FIG. 1. Thus, the cavity in Wagner (unlike the “interior grip portion” of the present invention) could not “slidably embrace” a hockey stick (which must

Appl. No. 10/665,539
Amendment dated January 30, 2006
Response to Office Action of September 30, 2005

extend through both ends of such a cavity).

The claims as presented herein patentably distinguish from *Wagner* by, among other things, requiring that the hand shield permit a hockey stick to slidably move through the openings at both ends of the interior grip portion.

The Claims Are Not Anticipated By Powell

Applicants respectfully submit that the claims as currently amended, and as presented in the amendment dated December 16, 2004, distinguish from *Powell*. It is clear that the hand shield portion in *Powell* does not “slidably embrace” the telescopic shaft portion or any other object. Rather, the “cylindrical hand grip 20 is *rigidly secured* to the hand grip mounting section at 22 by appropriate securement means.” (Col. 2, lines 30-34) (emphasis added). Further, “[a]s may be best seen in the sectional view of FIG. 6, shaft section 28, the largest shaft section, is *securely attached to the handle portion 12 at the annular shoulder 26 by a suitable adhesive.*” (Col. 2, lines 51-54) (emphasis added).

As a result, the present claims patentably distinguish from *Powell*.

As a result, Applicants urge that amended claim 1 distinguishes patentably from the prior art. Further, because claims 2–8 and 10 are severally dependent, either directly or indirectly, on independent claim 1, they are to be construed as incorporating by reference all of the limitations of that main claim. Hence, if independent claim 1 distinguishes patentably from the prior art, then each of the dependent claims 2–8 and 10 must similarly so distinguish. Accordingly, claims 1–8 and 10 are believed to be in condition for allowance.

Appl. No. 10/665,539
Amendment dated January 30, 2006
Response to Office Action of September 30, 2005

This Amendment and these remarks are believed to be fully responsive to the Office Action mailed September 30, 2005, are believed to squarely address each and every ground for rejection or objection raised by the Examiner, and are further believed to materially advance prosecution of this application toward immediate allowance.

Formal allowance of claims 1-8 and 10 is therefore courteously solicited.

Respectfully submitted,

PHILLIPS LYTTLE LLP

By 

Michael J. Berchou
Reg. No. 48,233
3400 HSBC Center
Buffalo, New York 14203
Telephone: (716) 847-8400
Telecopier: (716) 852-6100

Attorneys for Applicants


Buffalo, New York
Dated: January 30, 2006

CERTIFICATE OF MAILING

I certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Mail Stop Non-Fee Amendments, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on January 30, 2006.

PHILLIPS LYTTLE LLP




By 
Michael J. Berchou, Esq.
Reg. No. 48,233
Signed: January 30, 2006

CERTIFICATE OF FACSIMILE TRANSMISSION

I certify that this correspondence is being forwarded transmitted by facsimile transmission to Examiner Mitra Aryanpour at (571) 273-8300 on January 30, 2006.

PHILLIPS LYTTLE LLP

By 
Michael J. Berchou, Esq.
Reg. No. 48,233
Signed: January 30, 2006